

REMARKS

The Examiner's Office Action of June 6, 2005 has been received and its contents reviewed. Applicants would like to thank the Examiner for the consideration given to the above-identified application.

Claims 1-18 are pending for consideration, of which claims 1, 4, 7, 10, 13 and 16 are independent. In view of the above actions and the following remarks, reconsideration of this application is now requested.

Initially, non-elected claims 19-33 have been withdrawn with traverse. As submitted previously, Applicants respectfully traverse the Restriction Requirement as being outside the boundaries established in MPEP §§ 806.04(e) and 806.04(f). First, the Restriction Requirement appears to be based solely on a finding that the different inventions are patentably distinct, without any evaluation whatsoever made with respect to whether or not the inventions are "specifically different embodiments" as required in MPEP § 806.04(e). Furthermore, the outstanding Restriction Requirement fails to provide any basis for finding that the restricted claims are mutually exclusive as required by MPEP § 806.04(f). Indeed, merely finding that claims are patentably distinct does not provide a basis for requiring an election of inventions, since if that were the case every dependent claim ever submitted in an application would be properly the subject of a Restriction Requirement, which of course is not the case.

In light of the deficiencies above-identified in the outstanding Restriction Requirement, it is respectfully submitted that certainly claims 19-33 are not properly established as being directed to different mutually exclusive inventions, and at the very least it is respectfully submitted that these claims should be examined in the present

Claims 1-18 stand rejected under 35 U.S.C. §103(a) as unpatentable over Hinata et al. (U.S. Patent No. 5,610,742 – hereafter Hinata) in view of Eida et al. (U.S. Patent No 5,869,929 – hereafter Eida). This rejection is respectfully traversed at least for the reasons provided below.

In the rejection, the Examiner admitted that Hinata fails to disclose a light-emitting element comprising an anode, a layer including a luminescent material and a cathode provide between the pair of substrates. To cure the deficiency of Hinata, the Examiner applied Eida as teaching the aforementioned claimed features. In response, Applicants respectfully submit that Hinata discloses a liquid crystal display device

and not a light emitting element. Applicants respectfully assert that the structure and function of the liquid crystal display device are quite different from that of the display device including the light emitting element having a luminescent material of the presently claimed invention.

The requirements for establishing a *prima facie* case of obviousness, as detailed in MPEP § 2143 - 2143.03 (pages 2100-122 - 2100-136), are: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the teachings; second, there must be a reasonable expectation of success; and, finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. Therefore, without motivation or suggestion to combine the LCD device of Hinata and multicolor luminescent device of Eida, and since each of these references belong to a different type of device having different structure and function, their combination is improper and a *prima facie* case of obviousness has not been established.

In view of the arguments set forth above, Applicants respectfully request reconsideration and withdrawal of all the pending §103(a) rejection.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with Applicants' representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Respectfully submitted,



Luan C. Do
Registration No. 38,434

NIXON PEABODY LLP
Suite 900
401 9th Street, N.W.
Washington, D.C. 20004-2128
Telephone: (202) 585-8000
Fax: (202) 585-8080